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| 10/581,552 | 03/20/2007 | Alan Wilson | P08943US00/RFH | 6221 |

881 7590 10/18/2010
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| EXAMINER |
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AYCHILLHUM, ANDARGIE M

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| ART UNIT | PAPER NUMBER |
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2835

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10/18/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iplaw@stites.com

| | | | |
|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 10/581,552 | Applicant(s) WILSON ET AL. | |
| | Examiner ANDARGIE M. AYCHILLHUM | Art Unit 2841 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>08/28/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

2. Applicant's arguments filed 06/28/210, with respect to Election/Restriction have been fully considered and are persuasive. The previous restriction has been withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4, 8-9, 12-17, 22-28, 30, 33-34, 37-39 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Hailey (US 6,349,038 B1).

Pertaining to claims 1, 25 and 26, Hailey discloses an electrical component (see fig. 4A), involving: bonding a thin metal foil (302, see fig. 4) to an insulating substrate (300, see fig. 3) and thereby forming a component blank having a metal face that comprises a surface of said metal foil (302); laser machining at least the metal foil (302) of said component blank to produce at least one trench (306, see figs. 3-4a) for defining one or more foil tracks, said trench being at least equal in depth (see figs. 3-4a)

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to the thickness of the foil so as to prevent current flow across the trench; and filling said trench with a trench filling material (dielectric-filled moat 306, see column 5, lines 16-20) without overlaying said metal face with said trench filling material (dielectric-filled moat 306, see column 5, lines 16-20).

Pertaining to claims 2 and 28, Hailey further discloses including performing said laser machining by means of a laser with a cutting width (the width of the 306), and creating foil tracks with a spacing approximately equal to said cutting width (see figs. 3-4A).

Pertaining to claims 4, 30 and 33, Hailey further discloses wherein said trench filling material is an insulating material (dielectric-filled moat 306, see column 5, lines 16-20).

Pertaining to claim 7, Hailey further discloses said trench filling material (dielectric-filled moat 306, see column 5, lines 16-20) is a dielectric material and said electric component is a sensor that responds to changes in said dielectric material (dielectric-filled moat 306, see column 5, lines 16-20) .

Pertaining to claim 8, Hailey further discloses electrical component (see fig. 4A) is a foil sensor, and said method further comprises forming said metal foil (302) from a parent foil that is substantially identical with the material of the structure to be monitored (see fig. 4).

Pertaining to claim 9, Hailey further discloses laser machining said component blank to produce one or more back slots, said back slots being equal in depth to the full thickness of said component blank (see figs. 3-4)

Pertaining to claims 12 and 13, Hailey further discloses preparing the metal foil (302) by machining a sample of parent material to a desired final thickness (see figs 3-4A).

Pertaining to claim 14, Hailey further discloses preparing the metal foil (302) for said bonding by applying a chemically resistant film to a first face of said foil, and applying a bond enhancer to the other face of said foil, wherein said first face is ultimately the exposed face and said chemically resistant film protects said first face from said bond enhancer (see figs. 3-4A).

Pertaining to claim 15, Hailey further discloses drying said foil and then removing said film (see figs. 3-4A).

Pertaining to claim 16, Hailey further discloses chemically resistant film comprises a polyester tape (see paragraph [0368] of Hirose).

Pertaining to claim 17, Hailey further discloses said insulating material is chosen to have an ablation rate that is sufficiently low to prevent unwanted penetration

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of the substrate (see figs. 3-4A) during machining to remove said foil (see figs. 3-4A).

Pertaining to claims 22 and 34, Hailey further discloses said electrical component (see fig. 4A) is selected from the group of: a linear polarization resistance gauge; a corrosion sensor; a resistance sensor; a non-destructive testing sensor; a spiral inductor; a delay line; a capacitor; and a sensor responsive to changes in a dielectric: material (column 5, lines 26-32).

Pertaining to claims 23 and 37, Hailey further discloses said trench with a ratio of depth to width of from 1:1 to 7:1, (see figs. 3-4A).

Pertaining to claims 24 and 38, Hailey further discloses said trench with side walls that are substantially straight (see figs. 3-4A).

Pertaining to claims 27 and 42, Hailey further discloses an electrical component (see fig. 4A), involving: bonding a thin metal foil (302, see fig. 4) to an insulating substrate (300, see fig. 3) and thereby forming a component blank having a metal face that comprises a surface of said metal foil (302); laser machining at least the metal foil (302) of said component blank to produce at least one trench (306, see figs. 3-4a) for defining one or more foil tracks, said trench being at least equal in depth (see figs. 3-4a) to the thickness of the foil so as to prevent current flow across the trench; and filling said trench with a trench filling material (dielectric-filled moat 306, see column

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5, lines 16-20) without overlaying said metal face with said trench filling material (dielectric-filled moat 306, see column 5, lines 16-20) does not overlay said metal face. (see figs. 3-4a).

Pertaining to claim 39, Hailey further discloses said substrate (see fig. 4) is formed of a material having a sufficiently low rate of ablation to prevent unwanted penetration of the substrate during machining (see figs. 3-4A).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3, 10-11, 29 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hailey (US 6,349,038 B1).

Pertaining to claim 3 and 29, Hailey discloses all the claimed limitations except the minimum cutting width are from 25 μm and the maximum value is 30 μm .

However, the width of a split of cutting width with respect to the first metallic conducting part and second metallic part is equal.

Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the minimum value of the cutting width is 25 μm and the maximum value of the cutting width is 60 μm , since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Pertaining to claims 10, 11 and 43, Hailey discloses all the claimed limitations except the producing slots of approximately 150 μm lengths at 1.5 mm intervals.

However, producing slots and the length of the interval is equivalent to the metallic conducting part.

Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the minimum value of the producing slot is 150 μm and the maximum value of the cutting lengths is 1.5 mm interval, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

7. Claims 5 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hailey (US 6,349,038 B1) in view of Hirose et al. (US 2004/0025333 A1).

Pertaining to claim 5 and 31, Hailey discloses said insulating material (dielectric-filled moat 306, see column 5, lines 16-20)

But, Hailey does not explicitly teach if the insulating material is made of polymer.

However, Hirose et al. teaches the insulating material is made of polymer.

Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to make the insulating material of Hailey out of polymer based on the teachings of Hirose et al. in order to have relatively low melting points and low cost.

8. Claims 18-21, 35-36 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hailey (US 6,349,038 B1) in view of Chen et al. (US 2005/0116718 A1).

Pertaining to claims 18 and 40, Hailey discloses said insulating substrate (300, see fig. 3).

But, Hailey does not explicitly teach if the insulating material is comprises a plurality of layers of fiberglass prepreg.

However, Chen et al. teaches the insulating material is comprises a plurality of layers of fiberglass prepreg (see paragraph [0007]).

Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to make the insulating substrate of Hailey comprise a plurality of layers of fiberglass prepreg based on the teachings of Chen et al. in order to provide a non-conductive structure for mounting components.

Pertaining to claims 19, 20 and 41, Hailey as modified by Chen et al. further discloses said electrical component is a foil sensor, and the method further comprises

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preparing said component blank by coating said component blank on the surface comprising the ultimate sensor (see paragraph [0007] of Chen et al.) side of said sensor blank with a chemically resistant coating solution, to protect said surface from contamination during sensor processing (see paragraph [0007] of Chen et al.).

Pertaining to claims 21 and 35, Hailey as modified by Chen et al. further discloses electrical component comprises two or more different types of foil sensors (see paragraph [0007] of Chen et al.).

Pertaining to claim 36, Hailey discloses all the claimed limitations except the metal foil has a thickness in the range of 15 to 200 μm .

However, the range of metal foil with respect to the first metallic conducting part and second metallic part is equal.

Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the metal foil thickness with the range of 15 to 200 μm , since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boeschu, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDARGIE M. AYCHILLHUM whose telephone number is (571) 270-1607. The examiner can normally be reached on (Mon-Fri from 8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee Lee can be reached on 571-272-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.A.
September 30, 2010

/Tuan T Dinh/
Primary Examiner, Art Unit 2841

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